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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,682	01/17/2006	Alexander Schroeck	26994U	1169

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THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

EXAMINER

RIPA, BRYAN D

ART UNIT	PAPER NUMBER
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1723

MAIL DATE	DELIVERY MODE
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03/09/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,682	Applicant(s) SCHROECK ET AL.	
	Examiner BRYAN D. RIPA	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,10-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 10, 11, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2011 has been entered.

Response to Amendment

In response to the Remarks received on February 2, 2011:

- claims 1, 3-5, 7, 10-24, 26 and 27 are presently pending
- claims 12-24 are withdrawn
- claims 1, 3-5, 7, 10, 11, 26 and 27 are rejected

Claim Interpretation

2. Claim 1 continues to claim in the preamble: "wherein said shaped dental parts are electrodeposited by securing at least one electrode to a part or model to be coated by electrodeposition" (see claim 1 at lines 4-6).

The Examiner wishes to point out that Applicant's claim is directed towards an apparatus for electrodeposition of shaped dental parts. Please note, as discussed in

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MPEP section 2115, in apparatus claims directed to machinery which works upon an article the material or article to be worked upon does not limit the structure being claimed. Here, the Examiner is treating the limitations directed to the shaped dental parts as the article to be worked upon by the electrodeposition apparatus.

Consequently, the limitations relating to the dental part to be worked upon by the electrodeposition apparatus are not being given any patentable weight.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

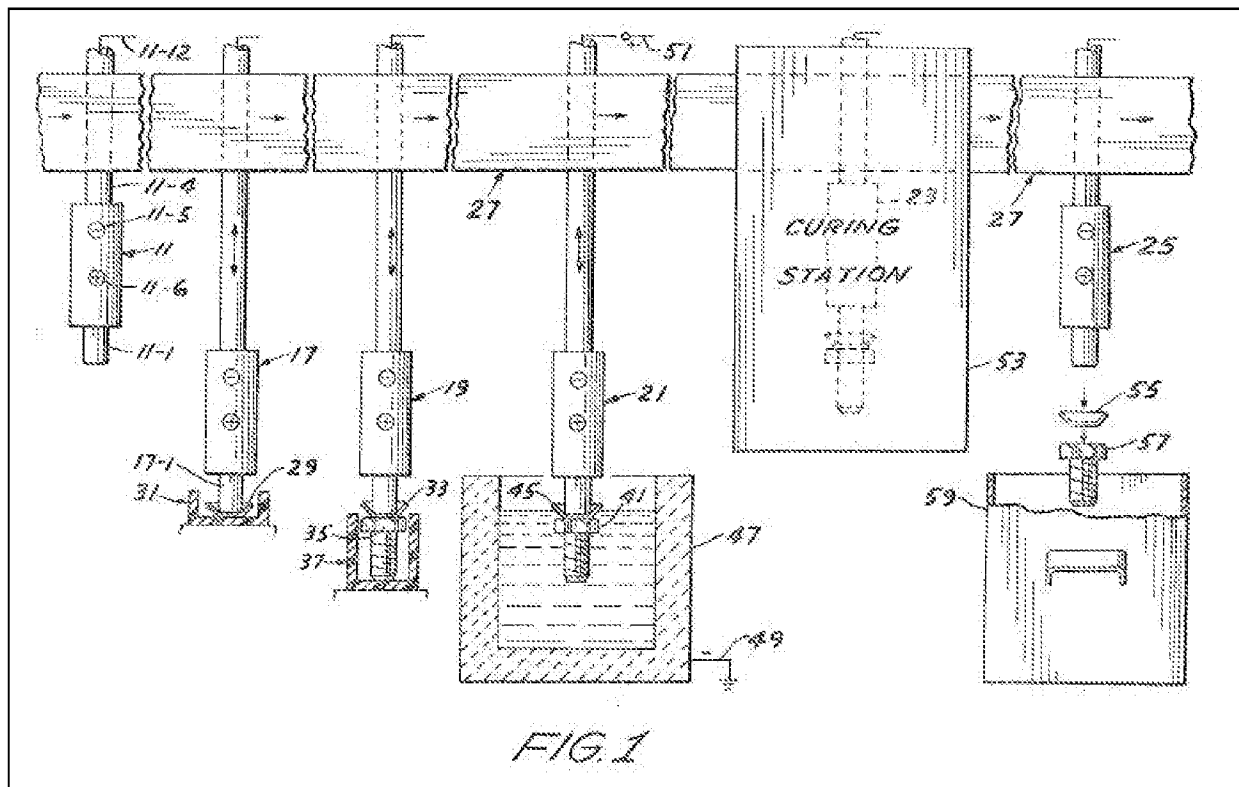
3. Claims 1, 4, 5, 7, 10, 11, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Pat. No. 3,575,832) (hereinafter referred to as "JOHNSON").

Regarding claim 1, JOHNSON teaches an apparatus for electrodeposition which is capable of functioning for the electrodeposition of shaped dental parts such as skeletons for crowns, inlays, bridges and the like which are electrodeposited by securing at least one electrode to a part or model to be coated by electrodeposition (see generally col. 1 lines 20-22 teaching the apparatus for the electrodeposition of small objects) having at least one current/voltage source and electrodes which can be arranged in a vessel that can be filled with an electrolyte (see col. 3 lines 34-36 teaching

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the workpiece being electrically connected to a power source that acts as an electrode; see also col. 3 lines 29-34 teaching tank 47 being filled with a coating bath, i.e. an electrolyte), the apparatus comprising:

- there is at least one magnetic connecting means for producing the electrical contact for the electrodeposition between at least one electrode and the current/voltage source (see col. 1 lines 49-58 teaching the assembly 21 comprising an electromagnet acting as a magnetic connecting means through which electrical contact is made to the workpiece);
- the magnetic connecting means comprising two parts which interact with one another through magnetic force (see assembly 21 and workpiece 41 comprising two parts which interact with one another through magnetic force);
- one part of the two parts of the magnetic connecting means connected to the current/voltage source (see assembly 21 electrically connected to conductor 51 which is connected to the power source; see also col. 3 lines 34-36); and
- one part of the two parts of the magnetic connecting means connected to an electrode (see assembly 21 and col. 3 lines 34-36 teaching bolt 41, i.e. the workpiece, connected to the power supply through assembly 21 so as to act as an electrode during the electrodeposition). See figure 1 below.



Regarding claim 4, JOHNSON teaches the apparatus for electrodeposition wherein the magnetic connecting means comprises a magnet and magnetizable metal part (see assembly 21 and bolt 41 above comprising an electromagnet, i.e. a magnet, and a magnetizable metal part). See figure 1 above.

Regarding claim 5, JOHNSON teaches the apparatus for electrodeposition wherein the magnet has a round cross-sectional area (see core 17-1 comprising the contact of the electromagnet and having a round cross-sectional area). See figure 1 above.

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Regarding claim 7, JOHNSON teaches the apparatus for electrodeposition wherein the connection of the part connected to the current/voltage source comprises a connection to a head or cover part located above the vessel during electrodeposition (see assembly 21 comprising a head or cover part which is located above tank 47).

Regarding claim 10, JOHNSON teaches the apparatus for electrodeposition wherein the electrode or the electrode part is of a rod-like design (see assembly 21). See figure 1 above.

Regarding claim 26, JOHNSON teaches the apparatus for electrodeposition wherein the magnet has a round cross-sectional area (see core 17-1 comprising the contact of the electromagnet and having a round cross-sectional area). See figure 1 above.

Regarding claim 27, JOHNSON teaches the apparatus for electrodeposition wherein the magnet is arranged in a sleeve-like receptacle in the electrode or in the electrode part (see thimble 45 acting as a sleeve like component that is arranged around the electromagnet connecting core in assembly 21). See figure 1 above.

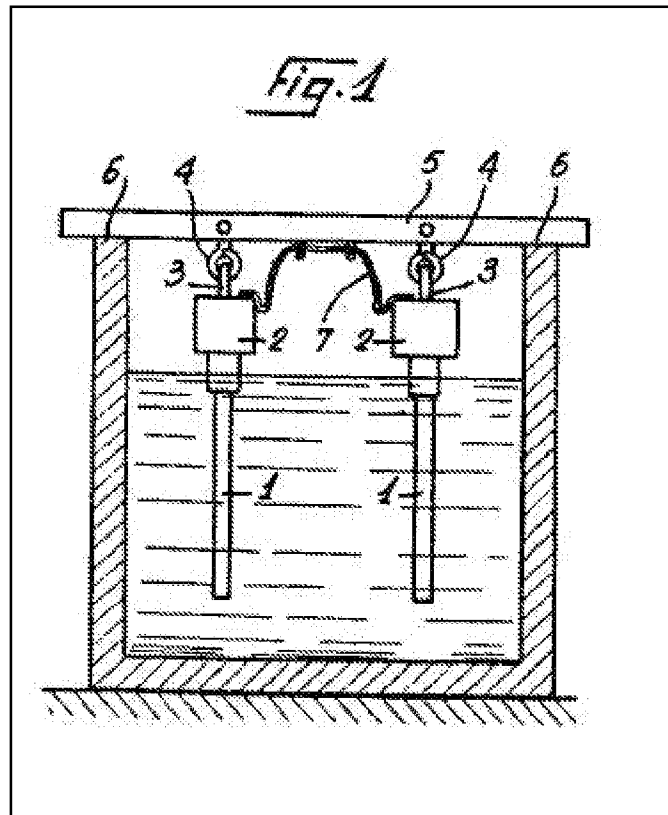
4. Claims 1, 3-5, 7, 10, 11, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bozel (FR Pat. No. 1,226,638) (hereinafter referred to as "BOZEL").

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Regarding claim 1, BOZEL teaches an apparatus for electrodeposition which is capable of functioning for the electrodeposition of shaped dental parts such as skeletons for crowns, inlays, bridges and the like which are electrodeposited by securing at least one electrode to a part or model to be coated by electrodeposition (see figure 1 below and the first paragraph on page 1 describing the invention pertaining to the supports or mountings provided to attach parts to be electroplated with the electrical power supply) having at least one current/voltage source and electrodes which can be arranged in a vessel that can be filled with an electrolyte (see top of page 5 teaching bar 5 being connected with a current source and parts 1 acting as electrodes which are undergoing electrolysis), said apparatus comprising:

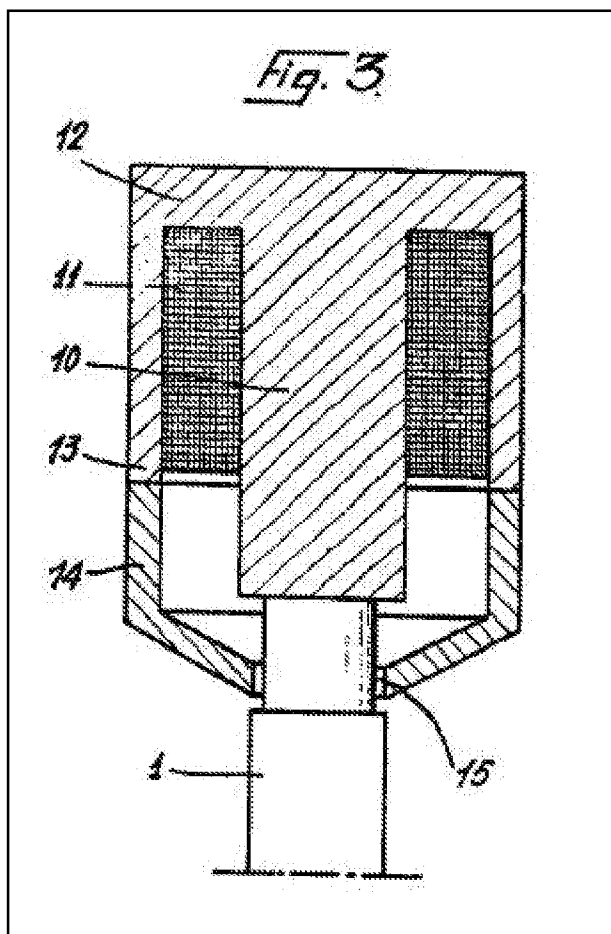
- at least one magnetic connecting means for producing the electrical contact for the electrodeposition between at least one electrode and the current/voltage source (see mounting 2 below and first and third paragraphs on page 5);
- said magnetic connecting means comprising two parts which interact with one another through magnetic force (see first and third paragraphs on page 5);
- one part of said two parts of the magnetic connecting means connected to the current/voltage source (see bar 5 which as discussed in first and third paragraphs on page 5 are connected to the current source); and
- one part of said two parts of the magnetic connecting means connected to an electrode or part of an electrode (see part 1 acting as an electrode as claimed).

See figure 1 below.



Regarding claim 3, BOZEL teaches the apparatus wherein the magnetic connecting means comprises two magnets (see mounting 2 in figure 1 above showing multiple mountings each of which would contain a magnet).

Regarding claim 4, BOZEL teaches the apparatus wherein the magnetic connecting means comprises a magnet and a magnetizable metal part (see figure 3 depicting central core 10 which is magnetic and part 1 which is made of a magnetizable metal).



Regarding claims 5 and 26, BOZEL teaches the apparatus wherein the magnet has a round cross-sectional area (see fourth paragraph on page 5 teaching the mounting 2 of figure 3 comprising an annular and disc shaped components thereby implicitly teaching the core 10 having a round cross-section).

Regarding claim 7, BOZEL teaches the apparatus wherein the connection of the part connected to the current/voltage source comprises a connection to a head or cover part located above the vessel during the electrodeposition (see figure 3 above depicting

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mounting 2 which is the part connected to the current/voltage source having ring 14, i.e. a head or cover part, which is located above the vessel during electrodeposition).

Regarding claim 10, BOZEL teaches the apparatus wherein the electrode or the electrode part is of a rod-like design (see part 1 in figure 1 being of a rod-like design).

Regarding claims 11 and 27, BOZEL teaches the apparatus wherein the magnet is arranged in a sleeve-like receptacle in the electrode or in the electrode part (see figure 3 above showing part 1 in contact with disc 12 so as to form a sleeve-like receptacle).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3, 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JOHNSON as applied to claim 1 above.

Regarding claim 3, JOHNSON does not explicitly teach the apparatus for electrodeposition wherein the magnetic connecting means comprises two magnets.

However, it would have been obvious to one of ordinary skill that with more complex workpieces, i.e. having more intricate structures, the addition of a second

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magnetic contact point or a second electromagnet might be required. In fact, the need to apply several contact points was considered by JOHNSON (see col. 4 lines 12-16 teaching the need to tailor the number of contact points depending upon the application).

Furthermore, the mere duplication of parts, without any new or unexpected results, is within the ambit of one of ordinary skill in the art. See *In re Harza*, 124 USPQ 378 (CCPA 1960) (see MPEP § 2144.04).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add an additional magnetic contact point depending on the shape and weight of the workpiece so as to have two magnets as claimed.

Regarding claim 5, JOHNSON teaches the apparatus for electrodeposition wherein the magnet has a round cross-sectional area (see core 17-1 comprising the contact of the electromagnet and having a round cross-sectional area). See figure 1 above.

Regarding claim 11, JOHNSON teaches the apparatus for electrodeposition wherein the magnet is arranged in a sleeve-like receptacle in the electrode or in the electrode part (see thimble 45 acting as a sleeve like component that is arranged around the electromagnet connecting core in assembly 21). See figure 1 above.

Response to Arguments

Applicant's arguments filed February 2, 2011 have been fully considered but they are not persuasive.

Applicant's arguments are not persuasive because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Additionally, the Examiner wishes to point out that Applicant's recitation of the status of the claims as contained in the Remarks filed on February 2, 2011 appears to be directed towards the Non-Final Office Action dated November 17, 2009 and not directed towards the Final Rejection mailed August 3, 2010. In the Final Rejection claims 1, 4, 5, 7, 10, 11, 12, 26 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by JOHNSON; claims 1, 3-5, 7, 10, 11, 26 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by BOZEL; and claims 3, 5, and 11 were rejected under 35 U.S.C. 103(a) as being obvious over JOHNSON.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN D. RIPA whose telephone number is 571-270-7875. The examiner can normally be reached on Monday to Friday, 9:00 AM to 5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1723

/B. D. R./
Examiner, Art Unit 1723